

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CATHY J. LENTZ

Appeal No. 2000-0917
Application No. 09/104,763

ON BRIEF¹

Before ABRAMS, FRANKFORT, and NASE, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the refusal of the examiner to allow claims 1 to 3 and 5 to 11, as amended subsequent to the final rejection. These claims constitute all of the claims pending in this application.

¹ On January 18, 2001, the appellant waived the oral hearing (see Paper No. 15) scheduled for February 21, 2001.

We REVERSE.

BACKGROUND

The appellant's invention relates to a portable audio entertainment apparatus containing separately carried signal and sound producing portions. Claim 1, the sole independent claim on appeal reads as follows:

A method of operating a vehicle, comprising:
providing an audio system having a signal producing portion and a sound producing portion;
carrying the sound producing portion on the vehicle;
wearing the signal producing portion on a person;
and
coupling the signal producing portion to drive the sound producing portion while the signal producing portion is being worn on the person.

A copy of the claims 2, 3 and 5 to 11 is set forth in the appendix to the appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Curley, Jr. (Curley)	4,500,019	Feb. 19, 1985
Villanueva et al. (Villanueva)	4,756,454	July 12, 1988
Dixon	4,856,364	Aug. 15, 1989
Rogowski	4,981,243	Jan. 1, 1991
Davis	5,426,570	June 20, 1995

Claims 1-3, 6, 7, 9/1, 9/2, 9/3, 9/6, 9/7, 11/1, 11/2, 11/3, 11/6 and 11/7 stand rejected under 35 U.S.C. § 103 as being unpatentable over Villanueva in view of Curley.

Claims 5, 9/5 and 11/5 stand rejected under 35 U.S.C. § 103 as being unpatentable over Villanueva in view of Curley and Davis.

Claims 8, 9/8 and 11/8 stand rejected under 35 U.S.C. § 103 as being unpatentable over Villanueva in view of Curley and Dixon.

Claims 10/1, 10/2, 10/3, 10/6 and 10/7 stand rejected under 35 U.S.C. § 103 as being unpatentable over Villanueva in view of Curley and Rogowski.

Claim 10/5 stand rejected under 35 U.S.C. § 103 as being unpatentable over Villanueva in view of Curley, Davis and Rogowski.

Claim 10/8 stand rejected under 35 U.S.C. § 103 as being unpatentable over Villanueva in view of Curley, Dixon and Rogowski.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the final rejection (Paper No. 5, mailed April 27, 1999) and the answer (Paper No. 11, mailed October 12, 1999) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 9, filed September 28, 1999) and reply brief (Paper No. 12, filed December 10, 1999) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness

with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 1 to 3 and 5 to 11 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A critical step in analyzing the patentability of claims pursuant to 35 U.S.C. § 103 is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher." Id. (quoting W.L. Gore &

Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983)).

Most if not all inventions arise from a combination of old elements. See In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. See id. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See id. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the appellant. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature

of the problem to be solved. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. In addition, the teaching, motivation or suggestion may be implicit from the prior art as a whole, rather than

expressly stated in the references. See WMS Gaming, Inc. v. International Game Tech., 184 F.3d 1339, 1355, 51 USPQ2d 1385, 1397 (Fed. Cir. 1999). The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. See In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981) (and cases cited therein). Whether the examiner relies on an express or an implicit showing, the examiner must provide particular findings related thereto. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. Broad conclusory statements standing alone are not "evidence." Id.

With this as background, we analyze the prior art applied by the examiner in the rejection of claim 1.

Villanueva's invention relates generally to mounting brackets or carriers for releasably mounting portable audio equipment to other apparatus such as vehicles having a forward wheel controlled by a combination stem and handlebars, examples being bicycles, tricycles, mopeds and motorcycles. Villanueva teaches (column 1, lines 18-54) that

Operators of bicycles have heretofore had to do without audio entertainment unless they somehow carried audio equipment on their persons and used headphones to carry the sounds to their ears. . . .

In most states, the operator of a motorcycle cannot legally wear earphones because of the fact that earphones excessively attenuate ambient sounds, such as voices, horns and sirens. Safe driving laws require that the operator of a motor vehicle be aware of ambient sounds. Unfortunately, most states do not have the same restriction concerning bicycle riders. With the proliferation of personal portable, pocket size stereophonic audio equipment with earphones, the potential for dangerous situations is immediately apparent. There are many people, most notably children and teenagers, riding bicycles while wearing earphones.

In the absence of earphones, stereophonic equipment would need to be carried in front and centered, with respect to the operator, without inconveniencing the operator and without impairing the safe operation of the bicycle. One type of such apparatus exists where a combination radio with its speakers is removably mounted to the handlebars of a motorcycle. However, it is a rather sophisticated arrangement, much like an automobile radio installation, except that the housing for the radio and its associated speakers is mounted on rods some distance above the handlebars. It uses the motorcycle

power supply and is essentially a self contained, semi-permanent radio and speaker console. There has not previously been a practical and safe means adapted to couple an independent personal portable radio or tape player to a bicycle to provide adequate stereophonic sound without the need to use earphones.

Villanueva then provides (column 2, line 59, to column 2, line 49) that

A purpose of this invention is to provide a bicycle rider with a means for listening to stereophonic audio without the need for earphones and without attenuating ambient sounds. A resultant advantage is that a bicycle rider can have stereophonic entertainment without the potential safety impairment that would be caused by the use of earphones.

The invention will be described as it mounts and functions on a bicycle, but it applies equally well to any of the aforementioned vehicles having a forward wheel controlled by a combination stem and handlebars. As used herein, the term "audio equipment" refers to apparatus capable of producing electric signals which can be converted to audible sounds. "Personal portable stereo" may be a radio, tape player or a combination of both. It is normally pocket size and frequently has no speakers, only headphones.

This invention is an audio equipment carrier for vehicles of the type mentioned above. It primarily comprises a main body adapted to be removably affixed to the handlebars in a laterally centered position, a pair of speaker enclosures affixed to the main body, each housing a speaker, a releasable means for securing the audio equipment to the main body and a means for connecting the audio equipment to the speakers. That portion of the main body which is adapted to receive the

audio equipment is a generally horizontal, substantially planar surface at the top of the main body. The audio equipment is held in place on the carrier by means of a strap. A novel strap and buckle arrangement is disclosed which is adjustable to accommodate any appropriate size and shape audio equipment. It allows the audio equipment to be secured to or released from the carrier with one hand.

Another significant feature of this invention is that it is adaptable. It can be used in combination with many portable radios and tape players without modification. Furthermore, the audio equipment can be easily mounted to and removed from the carrier to prevent theft of the equipment. When parking the bicycle, the user can simply remove and carry the audio equipment until he or she returns to the bicycle.

. . . .

By using the carrier of this invention, the audio equipment is positioned in front of and centered with respect to the operator, and earphones are not needed to properly receive stereophonic audio. Such an arrangement is highly advantageous with respect to safety.

Curley's invention relates to an apparatus for carrying portable audio devices such as radios and tape players and in particular, to such an apparatus which may be securely and comfortably worn during a wide variety of physical activities.

Curley teaches (column 1, lines 56-60) that his carrier apparatus for portable audio devices is lightweight and may be worn without interference during a wide variety of physical

activities (e.g., running, bicycle riding, skiing, etc.).

Curley's carrier apparatus for portable audio devices includes an armband portion longitudinally wrappable about a wearer's upper arm and having an upper section which includes a first inflatable chamber, a lower section which includes a second inflatable chamber and an intermediate section interconnecting the upper and lower sections. The armband further includes one or more ports for introducing a fluid into the chambers to thereby inflate the chambers into a condition wherein the armband is laterally contoured to substantially conform to the muscular contour of the arm and thereby maintain a substantially fixed position along the length of the arm. A receptacle is attached to the armband for holding the portable audio device. As shown in Figure 1, earphones 26 are connected via a wire 28 and connector 30 to a jack in the portable radio or tape player 24 securely held in receptacle 22 and such earphones may be worn by runner R to enable him to listen to the audio device during running or other physical activity.

After the scope and content of the prior art are determined, the differences between the prior art and the claims at issue are to be ascertained. Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

Based on our analysis and review of Villanueva and claim 1, it is our opinion that the only differences are the following two limitations: (1) wearing the signal producing portion on a person; and (2) coupling the signal producing portion to drive the sound producing portion while the signal producing portion is being worn on the person.

With regard to these differences, the examiner determined (final rejection, p. 4) that

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Villanueva et al. with the signal producing portion worn on a person of Curley, Jr., because attaching the signal producing portion directly on [a] person allows the person to more easily operate the signal producing portion, wherein the functional buttons or switches are in [a] better position to be adjusted by the person. Furthermore, the signal producing portion is less likely to be stolen if the signal producing portion is worn by the person instead of being carried on the vehicle when the vehicle is left unattended.

We agree with the appellant's argument (brief, pp. 6-8; reply brief, pp. 2-8) that absent the use of impermissible hindsight there is no motivation, suggestion or teaching in the combined teachings of the applied prior art to arrive at the subject matter of claim 1. In that regard, it is our view that the applied prior art does not teach or suggest that (1) attaching the signal producing portion directly on a person as taught by Curley allows the person to more easily operate the signal producing portion than the position of the signal producing portion in the carrier as taught by Villanueva; and (2) a signal producing portion is less likely to be stolen if the signal producing portion is worn by a person instead of being carried on a vehicle.²

² In fact, Villanueva teaches that the audio equipment can be easily mounted to and removed from the carrier to prevent theft of the equipment. When parking the bicycle, the user can simply remove and carry the audio equipment until he or she returns to the bicycle.

For the reasons set forth above, the decision of the examiner to reject claim 1, and claims 2, 3 and 5 to 11 dependent thereon, under 35 U.S.C. § 103 is reversed.³

³ We have also reviewed the references to Davis, Dixon and Rogowski additionally applied in the rejection of some of the dependent claims but find nothing therein which makes up for the deficiencies of Villanueva and Curley discussed above regarding claim 1.

CONCLUSION

To summarize, the decision of the examiner to reject
claims 1 to 3 and 5 to 11 under 35 U.S.C. § 103 is reversed.

REVERSED

NEAL E. ABRAMS)	
Administrative Patent Judge)	
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)	
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)	BOARD OF PATENT
CHARLES E. FRANKFORT)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JEFFREY V. NASE)	
Administrative Patent Judge)	

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